

## **Remarks**

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

The Examiner has correctly objected to the specification at page 2, paragraph 1 because the same includes "an embedded hyperlink and/or other form of browser-executable code." The latter objection has been rendered moot by cancelling the hyperlink/code and in lieu thereof inserting the complete name and address of the publishers of the two disclosures. Accordingly, this issue is considered moot.

Though the Examiner withdrew claims 23-26 and 29-52 from prosecution on the merits, the claims have been either cancelled or amended to avoid the non-elected species of the latter grouping of claims. Claims 23 through 27, 30, 31, 32, 34 through 38, 43, 44, 48 and 49 are generic. (Claim 23 has been cancelled and the subject matter thereof has been inserted into amended claim 20.) Additionally, original claims 1, 2, 3 and 8 through 21 remain generic. The claims added by this amendment are all generic and only claim 28 is directed to the elected species of Figures 1 through 9. Therefore, examination of each of the latter-identified claims is herewith respectfully requested.

The Examiner rejected claim 1 under "35 U.S.C. 102(b) as being anticipated by Smith et al. US #3,371,439." The Examiner's description of the Smith et al. disclosure at page 2, paragraph 5 of the Office Action is absolutely correct. However, claim 1 has been amended to not only overcome the patent Smith et al., but also to overcome the rejection "under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Walrath,

US #5,134,794," as set forth in the Office Action on page 3, paragraph 9 with respect to claim 4. As is readily apparent from amended claim 1, the subject matter of claim 4 has been incorporated into claim 1 to define the upper and lower hollow members as "each being made of **two** substantially hollow bodies disposed in substantially **mating opposing relationship**," etc. and defining respective upper and lower substantially hollow chambers. Thereafter, each of the side members is claimed as being "an individual tube having upper and lower end portions" with the side member upper and lower end portions "being disposed contiguous said respective upper and lower substantially hollow chambers." Finally, the last clause of amended claim 1 recites "means substantially filling and substantially rigidifying said hollow border." The latter is believed a fair and accurate description of the "scope and content of the prior art," as reflected by the Supreme Court decision of Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Next under consideration are the "differences between the prior art and the claims at issue." (Graham, supra.) There is no doubt that the teachings, as a whole, of Smith et al. and Walrath would result in "a sign comprising a hollow border of upper, lower and side members having identical front and back member that snap fit together (Figure 13) to form tubes (Figure 1)." Though perhaps left unstated by the Examiner is the fact that in accordance with the Walrath disclosure, the hollow border 1 "consists of two identical frame-halves 5 and 6 (FIG. 2) which are joined together as described below to form the holder. When the sign holder includes a base 4, each frame-half 5 and 6 is molded as a single piece structure including a base-half 4a as an integral element." (See Walrath, column 3, lines 4-9.)

The latter is very evident in Figure 2. Obviously, neither of the cited/applied patents discloses or renders obvious side members each being "an individual tube" and each of the individual tubes having "free upper and lower end portions." Finally, neither of the patent teachings or a combination thereof disclose the side member tube free upper and lower end portions being "disposed contiguous said respective upper and lower substantially hollow chambers." Accordingly, the "differences" of claim 4 are clearly neither anticipated nor rendered obvious by the combined teachings of the Smith et al. and Walrath patents. Accordingly, the formal allowance of claim 1 is considered proper and would be most appreciated.

With respect to claim 8, this claim depends from claim 1 and has been amended to call for the side member tube upper and lower end portions as being "in telescopic relationship to said respective upper and lower hollow members." The Examiner rejected claim 8 "under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Sachs-Lavery, US PGPUB 2004/0128894." Interestingly enough, the Examiner in describing the Sachs-Lavery publication states the same "teaches a sign including side members 12H and 12F which telescopingly engage the upper and lower members (Figures 1 and 3). The Examiner does not identify the upper and lower members, but these are obviously the respective members 12D and 12A, each of which also includes a horizontal top member 12E. In paragraph [0029] of the Sachs-Lavery publication, the Examiner will find the description of "four L-shaped frame members 12A, 12B, 12C and 12D," and these are said to be "slidably mated to straight members 12E, 12F, 12G and 12H such that their position relative to one another can be adjusted and fixed to form a rectangular frame that has a user-selected height H and

width W dimension as shown.” Figure 3 illustrates the tubular construction and the telescopic engagement of the tube 12H and the arm (unnumbered) of the L-shaped frame member 12C. Therefore, the teaching of Sachs-Lavery when considered in its entirety or as a whole, as is required under the Graham, supra, decision and the Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597 decision is that of utilizing four tubular L-shaped members or elbows and four individual tubes collectively telescopically united as is evident in Figure 1. The latter “teaches away” from the claimed invention of claim 8. (In re Gurley, 31 USPQ2d 1130-1131.)

It is quite evident that the Smith et al. patent discloses two frame members which can be snap-fit together (Figures 11 and 14) and within a border chamber 52 (Figure 14) a filler 120, such as plastic foam, can be inserted for stiffening purposes (column 4, lines 61-69). Thus, the issue is not that which Smith “does not teach,” but instead that which Smith and Sachs-Lavery teach **as a whole or their entireties**. In Smith et al., the Examiner has two frame members or borders which are totally continuous and are snap-fit together about the entire borders thereof with one entire border channel 52 (Figure 14) being filled with stiffening or reinforcing material (core 120) of Figure 12. In the Sachs-Lavery publication four individual tubes and four tubular L-shaped elbow members are telescopically united to each other. Neither of the patents disclose upper and lower hollow members each being made of **two** substantially hollow bodies disposed in substantially **mating opposing relationship**, etc. As was noted earlier, the patent to Walrath ('794) does not teach the latter because the entire two frame-halves 5, 6 are mated, and the structure lacks individual tubes having

free upper and lower ends. With due respect, any one, two or three of the latter prior art teachings may result in some obvious structure, but none render obvious the subject matter of claim 8. Accordingly, barring the citation of pertinent prior art, the formal allowance of claim 8 is considered to be in order and would be most appreciated.

The Examiner also applied the Smith et al. and Walrath patents in the rejection of claim 20 under 35 U.S.C. §103(a). Claim 20 has been amended to include therein the subject matter of now-cancelled claim 23, namely, the at least one hollow member is said to include "a pair of hollow projecting legs" with each of the "hollow projecting legs being in telescopic relationship to said one of said hollow side members." As was noted earlier, claim 20 remains generic and the subject matter thereof finds no counterpart in the prior art. Accordingly, the formal allowance of claim 20 and each of the claims depending therefrom is herewith respectfully requested.

For the record, it is also noted that the Examiner withdrew from further consideration claims 23 through 26 and 29 through 52 "as being drawn to a nonelected species." The elected species is that of Figures 1 through 9 and, as was noted earlier herein, those claims identified as being generic read upon the elected species and examination thereof is in order, including claim 20 and claim 30 which is similarly amended.

In view of the foregoing, the formal allowance of this application at an early date is herewith respectfully requested.

The undersigned has made a bonafide effort at placing this application in condition for allowance and upon the allowance of all of the claims which are generic and which are directed to the elected species (claim 28), the Examiner is authorized to cancel the non-elected claims of record. Should

the Examiner be of a mind to do anything other than allow all of the claims of record, he is requested to call the undersigned in order that a personal interview can be arranged at a date and time acceptable to the Examiner's schedule.

Respectfully submitted,  
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